



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,691	06/20/2003	Jean-Pierre Sommadossi	06171.IDX 1007 CONI	1388
57263 7590 12/29/2006 KING & SPALDING LLP 1180 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER MCINTOSH III, TRAVISS C	
			ART UNIT	PAPER NUMBER
			1623	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/602,691

Applicant(s)

SOMMADOSSI ET AL.

Examiner

Traviss C. McIntosh

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 130-152 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 130-152 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The Amendment filed October 6, 2006 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 1-129 have been canceled.

Remarks drawn to rejections of Office Action mailed May 30, 2006 include:

Double Patenting Rejections: which have been overcome by applicant's filing of the terminal disclaimers over patent 6,914,054, and application numbers 10/602,136; 10/602,142; and, 10/602,976, and have been withdrawn.

An action on the merits of claims 130-152 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

#### ***Double Patenting***

Claims 130, 132-146, and 150-152 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-3, 8-17, and 19-67 of copending Application No. 11/005,466. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering purine 2'-methyl-ribofuranosyl nucleosides and optionally in combination with another antiviral agent, using the same forms of compositions in the same patients. It is obvious that the instant application and the '466 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130-131 and 137-149 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11, 12, 17-25, and 43-65 of copending Application No. 10/609,298. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides using the same forms of compositions in the same patients. It is obvious that the instant application and the '298 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130-131 and 137-149 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-3, 8-17, and 19-52 of copending Application No. 11/005,440. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides using the same forms of compositions in the same patients. It is obvious that the instant application and the '440 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1623

Claims 130-131 and 133-149 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-17 and 19-66 of copending Application No. 11/005,443. It is noted that this application is currently abandoned, however, applicants have filed a petition to revive this application, so if the petition is approved, this rejection will be made. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides, optionally in combination with additional antiviral agents, using the same forms of compositions in the same patients. It is obvious that the instant application and the '443 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130, 132-146, and 150-152 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-17 and 19-68 of copending Application No. 11/005,444. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering purine 2'-methyl-ribofuranosyl nucleosides and optionally in combination with another antiviral agent, using the same forms of compositions in the same patients. It is obvious that the instant application and the '444 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130-131 and 133-149 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 3, 8-17 and 19-57 of copending Application No. 11/005,446. It is noted that this application is currently abandoned, however, applicants have filed a petition to revive this application, so if the petition is approved, this rejection will be made. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides, optionally in combination with additional antiviral agents, using the same forms of compositions in the same patients. It is obvious that the instant application and the '446 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130-131 and 137-149 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of US Patent No. 6,812,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering pyrimidine 2'-methyl-ribofuranosyl nucleosides using the same forms of compositions in the same patients. It is obvious that the instant application and the '219 patent are substantially overlapping.

Claims 130, 132-146, and 150-152 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-17 and 19-68 of copending Application No. 11/005,444. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering purine 2'-methyl-ribofuranosyl nucleosides and optionally in combination with another antiviral agent, using the same forms of compositions in the same patients. It is obvious that the instant application and the '444 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 130, 132-146, and 150-152 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-42 of US Patent No. 7,148,206. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering purine 2'-methyl-ribofuranosyl nucleosides and optionally in combination with another antiviral agent, using the same forms of compositions in the same patients. It is obvious that the instant application and the '206 patent are substantially overlapping.

Claims 130-152 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of US Patent No. 7,105,493. Although the

Art Unit: 1623

conflicting claims are not identical, they are not patentably distinct from each other because both applications are drawn to methods of treating HCV by administering purine and pyrimidine 2'-methyl-ribofuranosyl nucleosides and optionally in combination with another antiviral agent, using the same forms of compositions in the same patients. It is noted that while the '493 patent is drawn to treating flavivirus and pestivirus infections, HCV is known to be a flavivirus, as such, it would be obvious to use the method of treating a flavivirus in treating HCV, and visa-versa. It is obvious that the instant application and the '493 patent are substantially overlapping.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Traviss McIntosh  
December 14, 2006

Shaojia A. Jiang  
Supervisory Patent Examiner  
Art Unit 1623

A handwritten signature in black ink, appearing to read 'SAD 12/22/06', is written over a horizontal line.